REMARKS

Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative, as noted below.

Status of the Claims

Pending claims

Claims 216 to 240 are pending.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the new and amended claims. For example, support for claims and methods encompassing use of polypeptides that have a xylanase activity under various pH conditions can be found, inter alia, on page 20, lines 5 to 12, of PCT/US03/19153, filed June 16, 2003 (published as WO 03/106654, on December 24, 2003). Accordingly, no new matter has been added and the amendment can be properly entered.

The Group Restriction Requirement

The Office alleged that the pending claims of the application are directed to six (I to VI) separate and distinct inventions under 35 U.S.C. §121, as set forth on page 2, of the OA.

The Group Election, with traverse

Applicants hereby elect Group I, drawn to, inter alia, methods of making a composition comprising a xylanase, including claims 216 and 217, with traverse.

Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

The SEQ ID Species/Group Restriction Requirement

The Office also alleged that under 35 U.S.C. §121, the pending claims are directed to distinct inventions based on the various disclosed biological sequences (SEQ ID NO:s), as set forth on pages 3 to 23, of the OA.

The SEQ ID Species/Group Election

Applicants hereby elect SEQ ID NO:160, encoded e.g., by SEQ ID NO:159, with traverse.

Reasons to reconsider and withdraw the Group and the SEQ ID restriction requirement

Applicants respectfully request the Patent Office reconsider and withdraw the restriction requirement for the following reasons:

This application is a §371 national phase application

This application is a national phase application claiming benefit of priority under 35 U.S.C. §371 to Patent Convention Treaty (PCT) International Application Serial No: PCT/US03/19153, filed June 16, 2003; published as WO 03/106654, on December 24, 2003.

Applicants respectfully request the Patent Office rejoin all claims pending after entry of the instant amendment, including claims from Groups II to VI to the elected Group I for the following reasons:

Because this application is a §371 national phase application restriction is evaluated under:

PCT RULE 13
Unity of Invention

PCT RULE 13.1.
Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT RULE 13.2.
Circumstances in Which the Requirement of Unity of Invention Is To Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Further direction is provided in MPEP 1893.03(d) (MPEP Eighth Ed, Rev. 3, Aug. 2005, page 1800-200, 201):

> **MPEP 1893.03(d) Unity of Invention [R-2] - 1800 Patent Cooperation Treaty**
> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

Applicants respectfully aver that all pending claims in this application satisfy PCT Rule 13.2 in that they will share the novel inventive concept based use of a genus of polypeptides having xylanase activity that are active under a high temperature of at least 80°C and basic pH conditions of at least pH 10.5, or alternatively, use of a genus of polypeptides having xylanase activity that are active under a high temperature of at least 85°C and basic pH conditions of at least pH 11. Accordingly, Groups II to VI can be properly added back to the elected Group I.

Applicants must be allowed to claim their invention as they choose

Applicants respectfully request that they be allowed to claim the generic methods of claims 216 and 217 as they choose, and not be forced to incorporate unwanted limitations, i.e., be forced to incorporate a specific xylanase polypeptide. In other words, Applicants respectfully request claims 219 and 220 remain dependent claims.

All pending claims in this application satisfy PCT Rule 13.2 in that they will share the novel inventive concept based use of a genus of polypeptides having xylanase activity that are active under a high temperature of at least 80°C and basic pH conditions of at least pH 10.5, or alternatively, use of a genus of polypeptides having xylanase activity that are active under a high temperature of at least 85°C and basic pH conditions of at least pH 11. The individually listed polypeptides of claims 219 and 220 are merely alternative dependent claim limitations.

If this SEQ ID subgroup instant restriction requirement is allowed to stand, Applicants will not be allowed to claim their invention as they choose. If the invention is limited to use of a genus of polypeptides based on any one of the exemplary SEQ ID NO:s as set forth in claims 219 and 220, the full scope of the genuses claimed in now pending claims 216 and 217 will never be examined.

Even if Applicants filed divisional applications to all the SEQ ID NO: subgroups (i.e., all the SEQ ID NO:s listed in claims 219 and 220), the scope of the genuses claimed in now pending claims 216 and 217 will never be examined. In other words, if limitations from dependent genuses of claims 219 and 220 are incorporated into independent claims 216 and 217, then claims 216 and 217 as now pending would never be considered on its merits. The totality of all of the resulting narrower claims (each including use of a genus of polypeptides based on any one of the exemplary SEQ ID NO:s as set forth in claims 219 and 220) would not be the equivalent of now pending claims 216 and 217.

The procedure for handling applications that include generic claims is set forth in 37 CFR §1.146. This rule provides that "[i]n the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable."

As stated in MPEP §809.02(a), "[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141." Thus, where generic claims are present, an applicant can be required to elect a species for initial examination, but the generic claims are still subject to examination to determine whether such generic claims are allowable (emphasis added). MPEP §809.02(a); pg 800-52 to 800-53, 8th Edition, rev. 3, August 2005.

In the instant restriction requirement, this required procedure is not being followed. Claims 216 and 217 are proper generic claims within the requirements set forth in 37 CFR § 1.141. Claims 216 and 217 satisfy the definition of a generic claim as set forth in MPEP §806.04(d), in that they include limitations that are not present in all claims that depend from them. Therefore, an election of species requirement is permissible, but a restriction requirement is not. (MPEP §806.04(d), pg 800-42 to 800-43, 8th Edition, rev. 3, August 2005).

Moreover, because this restriction requirement splits claims 216 and 217 into multiple groups (the subgroups the Office alleges are patentably distinct), the restriction requirement is improper as a matter of law. The courts have long held that the section of the patent statute that

authorizes restriction practice, *i.e.*, 35 U.S.C. 121, provides no legal authority for not examining a broad generic claim. See, In re Weber, 198 USPQ 328, 331 (CCPA 1978); In re Haas, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and In re Haas 198 USPQ 334-337 (In re Haas II) (CCPA 1978). As stated in In re Weber:

> "The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it." 198 USPQ 328 at 334.

In a case such as the instant case, where a claim is generic, a restriction requirement is tantamount to a rejection of the claim. The CCPA made this point very clear in In re Haas I:

> "We find that the action taken by the examiner did in fact amount to a rejection. . . . Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content. In effect there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural applications could an examination of the patentability of their subject matter be obtained." 179 USPQ at 625.

If the instant restriction requirement is allowed to stand, Applicants will not be accorded "the basic right of the applicant to claim his invention as he chooses." In re Weber, 198 USPQ at 331. In In re Weber, the CCPA stated that "[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits" (198 USPQ at 331, emphasis in original). The Court went on to state that:

> "If . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification." 198 USPQ at 331.

Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of

invention. MPEP §803.02, pg 800-4 to 800-5, 8th Edition, rev. 3, August 2005. Even if Applicants were to file multiple divisional applications in addition to the instant application to obtain coverage for each of the alleged subgroups, Applicants would not have the opportunity to have their broader generic claim examined, i.e., Applicants would not have the opportunity to have that which they regard as their invention examined. The claims of the divisional applications would be limited to the particular subgroups (i.e., use of particular enzymes based on SEQ ID NO:s). One seeking to avoid infringement could simply choose an alternative enzyme that is not specifically claimed in any particular (divisional) application. In effect, the restriction requirement is reading into Applicants' independent claims limitations that are not present in the claims as filed. Claims 216 and 217 as filed and pending, for example, would never be considered, and thus never allowed, under the current restriction requirement. Only the dependent claims which are set forth in the respective subgroups would be examined.

Applicants therefore respectfully request that the instant restriction requirement with respect to all the SEQ ID subgroups be withdrawn (and rejoined as a generic restriction in Group I) and treated as though it were a species election under the procedure set forth in MPEP 809.02(a).

Pursuant to 37 C.F.R. § 1.144, Applicants reserve the right to petition for review of the restriction requirement at any time prior to appeal. Applicants also submit that because the instant restriction requirement is tantamount to a rejection of the generic claim 1, the restriction requirement is appealable to the Board of Patent Appeals and Interferences. In re Haas I. If the instant restriction requirement is allowed to stand, Applicants will not be accorded "the basic right of the applicant to claim his invention as he chooses." In re Weber. It is improper for the Office to refuse to examine that which Applicants regard as their invention. MPEP §803.02, pg 800-4 to 800-5, 8th Edition, rev. 3, August 2005.

Accordingly, Applicants respectfully request reconsideration of the restriction requirement and request that the restriction requirement with respect to all the SEQ ID NO: subgroups be withdrawn and treated as a species election under the procedure set forth in MPEP 809.02(a).

CONCLUSION

Applicants have elected the invention of Group I and SEQ ID NO:160, with traverse.

In this response Applicants traversed the restriction requirement and respectfully requested the Group and subgroup (SEQ ID NO:) restrictions be withdrawn, as discussed above. Applicants set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw the restriction requirement. Applicants have also requested that the restriction requirement with respect to all the subgroups be withdrawn and treated as a species election under the procedure set forth in MPEP 809.02(a). Accordingly, Applicants have preserved their right to petition the restriction to the Group Director under 37 CFR §1.144; see also MPEP §818.03(c); pg 800-60, 8th Edition, rev. 3, Aug. 2005. Applicants will defer submission of the petition (which can be deferred until allowance of the claims).

It is believed that the all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. **564462007901**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 720-5133.

Dated: January 10, 2008

Respectfully submitted,

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